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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,554	03/08/2002	Gunter Knoll	GRAT 19.083	5788

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EXAMINER

NGUYEN, PHONG H

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,554

Applicant(s)

KNOLL ET AL.

Examiner

Phong H Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 4-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Claim objections and Claim rejections under 35 USC 112 are withdrawn upon reviewing the Applicant's amendment~~s~~ filed on 05/24/2004.

Election/Restrictions

2. Applicant's election with traverse of claims 1-3 in the reply filed on 05/24/2004 is acknowledged. The traversal is on the ground(s) that both the method and the apparatus claims incorporate the distinctive and distinguishing feature of having only one portion of the bearing eye being fixed during the breaking process. This is not found persuasive because the present application was filed under 35 USC 371 and although the Examiner's restriction requirement was made under 35 USC 121, the restriction requirement is actually a holding of lack of unity of invention under PCT Rule 13. In this regard, Inventions I and II lack ~~of~~ unity for the following reasons: the special technical feature of Invention I is a means for holding with play the bearing eye without a pin retainer and the special technical feature of Invention II is a slide arrangement. The special technical feature of Invention I is not found in Invention II, and the specific feature of Invention II is not found in Invention I. Thus, unity of invention is lacking.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

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3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the European patent to Hekman in view of the European patent to Cavallo et al., hereinafter Cavallo.

Regarding claim 1, Hekman teaches method for breaking a machine component having a bearing eye into two bearing shells along a breaking plane, each bearing shell comprising one half of the bearing eye, the method comprising the following steps:

- positioning the machine component onto a two-piece split mandrel having first and second mandrel halves (56 and 59). See Figs. 6 and 7;

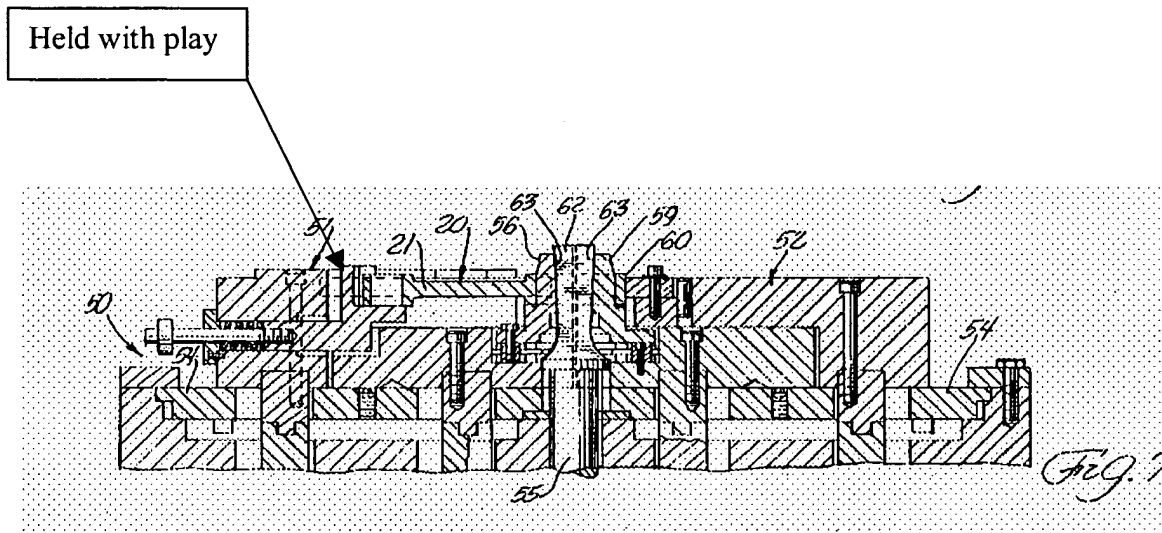
- fixing the position of the bearing eye relative to one mandrel half 59 on one side of the breaking plane by means of adjustable stops while on the other side of the breaking plane the bearing eye is not positionally fixed but is held with play relative to the other mandrel half in a longitudinal direction of a shank of the machine component; and

- driving a wedge 62 between the two mandrel halves (56 and 59) and breaking the bearing eye along the bearing plane into the first and second bearing shells so that the one bearing shell associated with the fixed position of the one mandrel half is simultaneously split from the other bearing shell associated with the other mandrel half and moved away from the other bearing shell along the breaking direction.

Hekman does not teach subjecting the bearing eye to an initial stress in a breaking direction by forcing the first and second mandrel halves apart, the breaking direction defined by the direction of movement of one bearing shell relative to the other bearing shell. Cavallo teaches subjecting the bearing eye to an initial stress in a breaking direction by forcing the first and second mandrel halves apart, the breaking direction defined by the direction of movement of one bearing shell relative to the other bearing shell. See the Abstract and Fig. 4. Therefore, it would have been obvious to one skilled in the art to subject the bearing eye to an initial stress in a breaking direction by forcing the first and second mandrel halves apart to make a cleaner fracture.

Regarding claim 2, the mandrel half associated with the positionally fixed bearing shell is moved away from the other mandrel half that is fixed to a frame, during the breaking of the bearing eye.

Regarding claim 3, the breaking resistance of the bearing eye is weakened on its inside along the breaking plane. See Fig. 5 in Hekman.



Response to Arguments

5. Applicant's arguments filed 05/24/2004 have been fully considered but they are not persuasive.

Regarding Applicant's arguments with respect to Cavallo, all the inventive features that the Applicant argues are not provided in claims 1-3; therefore, Hekman reads on the claims. Moreover, Cavallo is applied to teach subjecting the bearing eye to an initial stress to make a cleaner fracture but not the features that the Applicant argues.

Regarding Applicant's arguments with respect to Hekman that Hekman does not teach the other part of the machine component is positionally fixed with

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play, the Applicant is directed to Fig. 7 in Hekman provided in paragraph 3 of this Office Action.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H Nguyen whose telephone number is 703-305-4989. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PN: *pn*

August 24, 2004


Allan N. Shoap
Supervisory Patent Examiner
Group 3700